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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,116	10/04/2005	Luc Moens	2005_1215A	8632
513 7590 01/30/2007 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER LISTVOYB, GREGORY	
			ART UNIT	PAPER NUMBER
			1711	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/30/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/544,116

Applicant(s)

MOENS ET AL.

Examiner

Gregory Listvoyb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/04/2005</u> <u>02/08/05</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

Claims 1-4, 6-9 rejected under 35 U.S.C. 102(b) as being anticipated by Panandiker et al (US patent 5637654), herein Panandiker.

Panandiker discloses a carboxylic acid group containing amorphous polyester having an acid number of from 18 to 60 mg KOH/g ((Column 7, line 15) and prepared from a polyacid constituent comprising from 25 to 100% mole of isophthalic acid (column 6, line 5 and Table 1) and another aliphatic, cycloaliphatic or aromatic polyacid (column 6, line 50), and of a polyol constituent comprising about 15 -20% mole of one or more linear chain aliphatic C4 -C16 diol, 80-85 % mole of neopentyl glycol, from 15 to 20% mole of another linear chain aliphatic and/or cycloaliphatic diol (Column 6, line 30) and , optionally a polyol with 3 or more hydroxyl groups (column 6, line 60).

Regarding Claim 2, Panandiker teaches that a number averaged molecular weight ranging from 2000 to 5000 a glass transition temperature T<sub>g</sub>, measured with standard DSC method more than 45°C (Column 9, line 30 and Example 1), an ICI (cone/plate) viscosity accordingly to ASTM D4287, measured at 200°C ranging from 13 to 20 MPa.s (Poise) (Example 1).

Panandiker does not teach that Mn values measured by GPC. However, GPC is a most common method for MWD characterization. In addition, Panandiker's and Applicant's Zero Shear Viscosity data, which is closely connected to MWD values, are within the same range. Therefore, Panandiker's Mn data are inherently within the range that claimed by Applicant.

In reference to Claims 3 and 4, Panandiker teaches carboxylic acid component containing terephthalic acid and diol, containing 16% mol of 1,6 hexanediol (Column 6, line 30).

In reference to Claim 6, Panandiker teaches powdered thermosetting compositions which comprise a carboxylic acid group containing amorphous polyester and a cross-linking agent having at least two beta-hydroxyalkylamide groups (Column 7, line 40).

Regarding Claim 7, the content of powder thermosetting composition is illustrated in Examples 3-5 and Column 8, line 25.

In reference to claims 8 and 9, a coil coating composition prepares with electrostatic charging gun and heating at temperature of from 138C to 204C (Column 8, line 50).

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Claims 1-9 rejected under 35 U.S.C. 102(b) as being anticipated by Moens et al (WO 98/18862 and corresponding US patent 6635721).

Moens discloses an amorphous polyester containing 70-100% mol of Isophthalic acid 0-30% of at least one other aliphatic acid 70-100 mol% of neopentyl idol and 0-30mol% of at least one other aliphatic polyol (Abstract).

Moens teaches that polyester has an acid number within the range of 15-100 mg KOH, Mn, determined by GPC is within the range of 1100-15500, Tg is 40-80C and melt viscosity 5-15000 Mpa\* s (Claims 1, 10, 12, 13) and hydroxyalkylamide as a crosslinking agent in thermosetting coating composition (Claim 17).

Regarding Claims 3 and 4 Moens discloses fumaric, maleic acids and terephthalic acid and butanediol and hexanediol.

Regarding Claims 7, 8, 9, in Examples 1-14 Moens discloses different compositions with light adsorbers, crosslinking agents and pigments.

### ***Claim Rejections - 35 USC § 103***

Claims 1 and 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Panandiker.

Panandiker discloses an amorphous polyester based on an aromatic acid, including at least 25% mol of isophthalic acid and 80-85% mol of neopentyl glycol (NPG) and hexanediol.

Panandiker teaches a composition containing up to 100 % mol of isophthalic acid (IPA) (Table 1). However, he does not teach a composition, which simultaneously have 81% mol of IPA, 35 –65% mol of NPG and 15-65% of hexanediol.

Replacement of Terephthalic acid (TPA) with IPA decreases Tg of polyester and increases flexibility and weatherability of the coating. It may be especially important for, for instance, thin film applications. Therefore, it would be obvious to a person with ordinary skills in the art to replace majority of TPA to IPA in powder coating compositions to increase flexibility and weatherability of the polyester.

### ***Double Patenting***

Claims 1-9 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 11, 12, 13 and 17 of prior U.S. Patent No. 6635721. This is a double patenting rejection.

Claims 1-9 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No.

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10/544336. Although the conflicting claims are not identical, they are not patentably distinct from each other because they related to the same amorphous polyester and .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Listvoyb whose telephone number is (571) 272-6105. The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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